REMARKS

The Office Action mailed November 24, 2010 has been reviewed and carefully considered. No new matter has been added.

Claims 1-20 are pending.

Claims 1-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0203873 to Gray (hereinafter "Gray") in view of U.S. Patent No. 7,047,036 to Shaheen et al. (hereinafter "Shaheen") further in view of U.S. Patent Publication No. 2004/0156372 to Hussa (hereinafter "Hussa").

It is to be noted that the independent claims in the case are Claims 1, 7, and 13.

It is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "providing, responsive to said receiving step, a user with a menu option selection in a mobile device for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)", as recited in Claim 1.

Moreover, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "wherein a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)", as recited in Claim 7.

Further, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "providing, responsive to said mobile device receiving the location of the wireless local area network (WLAN), a user with a menu option selection for selecting a distance or distance range from the wireless service area of the wireless network to the location of the wireless local area network (WLAN)", as recited in Claim 13.

We initially note that the Examiner has admitted that Gray in view of Shaheen does disclose the above reproduced limitations of Claims 1, 7, and 13 (see, e.g., Office Action dated June 2, 2010, pp. 3, 7, and 10; and Office Action dated November 24, 2010, p. 5). Hence, the Examiner relied upon Hussa for disclosing the same. The Applicant respectfully disagrees with the Examiner's reading of Hussa and, hence, the rejections based on the same.

Against the aforementioned limitations of Claims 1, 7, and 13, the Examiner has cited paragraph [0029], lines 10-12, paragraph [0031], lines 1-6, and paragraph [0032], lines 1-6 of

Hussa. Paragraph [0029] of Hussa, inclusive of cited lines 10-12, is reproduced in its entirety as follows:

> FIG. 2 illustrates, in one embodiment, the basic steps of the service provision. When a user of a mobile communication network wants to know the location of a WLAN access point, he/she activates the service at the terminal (step 200). If the location method is network-based, a service request is sent from the terminal to the network. In response to the service activation, the current location of the terminal is determined utilizing known positioning methods (step 201). When the location has been determined, a set of access points is selected, the set including the most suitable access points, given the location of the terminal and the selection criteria (step 202). During the selection process, a key figure is calculated for at least some of the access points, the key figure indicating the rank order of the said access points. If the only selection criterion is the distance from the terminal, the key figure simply indicates the distance between the terminal and the access point. The key figure may be calculated for all access points available within the geographical area where the service is provided (service area) or only for the access points that meet a certain precondition, whereby the selection criteria include a precondition.

Paragraph [0031] of Hussa, inclusive of cited lines 1-6, is reproduced in its entirety as follows:

> The set selected may include only the access point with the best key figure or several access points having the best key figures. The user is then notified of the locations of the access points included in the set (step 203). This may be performed by showing the selected access points on a map shown on the display of the terminal device, for example.

Paragraph [0032] of Hussa, inclusive of cited lines 1-6, is reproduced in its entirety as follows:

> The selection criteria may be fixed or the user may give them in connection with the service request. The user may, for example, request the access points within a certain distance from his or her current location. The user may also indicate a route and request the access points that are located within a certain distance from the route.

As is evident, none of the cited portions of Hussa disclose that a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)", as essentially recited in Claims 1, 7, and 13. This is because THE SELECTION CRITERIA USED BY the approach of HUSSA IS ALWAYS PREDETERMINED CRITERIA (i.e., predetermined before receiving any access point locations). We note that the Abstract of Hussa characterizes such selection criteria as predetermined criteria, as does the description of every embodiment in Hussa.

For example, the Abstract of Hussa discloses the following "a set of access points belong to at least one WLAN access network is selected on the basis of **predetermined** criteria ..." (emphasis added).

Moreover, in paragraph [0010] of Hussa, Hussa discloses "In one embodiment, the invention includes a method.... The method includes the step of selecting a set of access points on the basis of at least one **predetermined** selection criteria ..." (emphasis added).

Further, in paragraph [0011] of Hussa, Hussa discloses "In another embodiment of the invention, a system ... is disclosed. The system includes ... selection means for selecting a set of access points on the basis of at least one **predetermined** selection criterion ..." (emphasis added).

Also, in paragraph [0012] of Hussa, Hussa discloses "In another embodiment, the invention provides a network element.... The network element includes ... a control unit, responsive to the receiver unit, for selecting a set of access points on the basis of at least one **predetermined** selection criterion ..." (emphasis added).

Predetermined selection criteria used by Hussa is either (pre-) fixed (i.e., before the specific request for service, namely of an access point location) or may be provided by the

user in connection with the (initial) request for WLAN location service (see, e.g., cited paragraph [0032] of Hussa reproduced above). However, as is readily evident in all cases, such selection criteria is provided to the user of the approach of Hussa BEFORE any location information of the WLAN is received by such user, in direct contrast to the explicit limitations recited in Claims 1, 7, and 13.

While the Examiner has referred to the PLMN disclosed in Hussa as having internal and external processes, and has further alleged that our argument is simply based on the external processes thus seeming to imply our failure to recognize the description of the internal processes as applicable to the subject matter of the pending claims, the Examiner then nonetheless refers to the external selection process in attempting to refute the Applicant's position (see, e.g., Office Action dated November 24, 2010, p. 3, Response to Arguments section). However, we respond to the same by pointing out that whether internal or external processes of the PLMN of Hussa are involved is irrelevant to the "critical" time (with respect to the aforementioned claim limitations) at which the selection criteria is provided in Hussa, i.e., BEFORE receiving the WLAN location information.

Thus, in all embodiments and variations disclosed in Hussa, the selection criteria are predetermined before the user ever receives any location information of the WLAN.

Referring back to paragraph [0029] of Hussa, we note that during the selection process of the set of most suitable access points based on the predetermined criteria, a key figure is calculated for at least some of the access points. Paragraph [0029] goes on to disclose that if the only selection criterion is the distance from the terminal, the key figure simply indicates the distance between the terminal and the access point. Thus, the key figure in such a case, which is a distance between the terminal and the access point, is provided TO the user and is, thus, NOT selected by the user, in direct contrast to the explicit limitations of Claims 1, 7, and 13.

Additionally, referring back to the Examiner's comments in the Response to Arguments section of the pending Office Action dated November 24, 2010, the Examiner noted our previous disagreement with the Examiner's position that Hussa does not include even one occurrence of the word "menu", let alone mention "menu option selection", let alone the remaining detailed limitations involving the same recited in Claims 1, 7, and 13. To our aforementioned assertion, the Examiner disagreed and pointed to paragraph [0031], lines 3-6 of Hussa and paragraph [0042], lines 21-23 of Hussa. Regarding paragraph [0031],

lines 3-6 of Hussa, the Examiner reasoned that the same discloses "The user is then notified of the locations of the access points included in the set, this may be performed by showing the selected access points on a map shown on the display (menu means) of the terminal device". Regarding paragraph [0042], lines 21-23 of Hussa, the Examiner reasoned that the same discloses "A terminal further includes a display unit 512 for displaying the locations of the access points (menu means) for the user". At the onset, we again note that the entire disclosure of Hussa fails to include even one occurrence of the word "menu" and so forth and, hence, the Examiner's characterization of the display as menu means is not based on the actual disclosure of Hussa. For example, if a mobile terminal display is capable of displaying a menu, and is even known to do the same, displaying a map in and of itself is not associated with, nor teaches or implies, the use of a menu, let alone menu option selection as recited in Claims 1, 7, and 13. Further, in providing the locations on a map, a person of skill in the art would not equate a map to a menu, let alone menu option selection as explicitly recited in Claims 1, 7, and 13. Moreover, we note that no disclosure follows in Hussa regarding the displaying of the locations on the map such that the user can select a distance or distance range at that time or even more relevantly there from.

For example, and further regarding paragraph [0032] in Hussa (reproduced above), we note that the same relates to the user providing the selection criteria before or at the (initial) time of the service request for a location of an access point and not responsive to the providing of such locations to the user, thus again being predetermined selection criteria in direct contrast to the explicit limitations recited in Claims 1, 7, and 13. Cited paragraph [0042] in Hussa is similar to paragraph [0032] in describing predetermined criteria (which is stored), again in direct contrast to the explicit limitations recited in Claims 1, 7, and 13.

Thus, HUSSA not only fails to teach or suggest the above reproduced explicit limitations recited in Claims 1, 7, and 13, but actually and explicitly TEACHES AWAY from the same. To that end, we note the following from MPEP §2141.02.VI: A prior art reference must be considered in its entirety, i.e., as a whole, INCLUDING PORTIONS THAT WOULD LEAD AWAY FROM THE CLAIMED INVENTION. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis added) (*see also*, MPEP §2141.02)). We further note the following from MPEP §2145.X.D.1:

> It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

Lastly, we note that by allowing a user at the mobile terminal as per Claims 1, 7, and 13 to specifically tailor search results (regarding the locations of multiple WLANs) to a particular distance or distance range UPON RECEIVING the location of the WLAN as per the above claims allows greater versatility, and enables a user to specifically take into account his or her particular circumstances with respect to driving towards a WLAN at the time when the user is initially informed of such locations and not at a prior time. For example, should a user notice that he or she has a certain (i.e., limited) amount of gas left, the user may want to restrict the range to a smaller range than that used by the communication network itself to provide the specified WLANs. In this way, the user may reduce the overall number of WLANs that have to be evaluated by the user at a time when such information is most useful and most applicable to the user's current circumstances and not pre-envisioned circumstances that may no longer exist. However, a predetermined distance cannot anticipate a situation that exists in the future for the user such as limited gas to arrive to a WLAN or other circumstances as readily contemplated by one of skill in the art given the teachings of the present principles provided herein. These and many other attendant advantages are present in the approach claimed in the above claims versus the prior art.

Hence, it is respectfully asserted that neither Gray nor Shaheen nor Hussa teach or suggest all of the above reproduced limitations of Claims 1, 7, and 13.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. *See In re Royka*, 490

F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Thus, Claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-6 and 19 directly or indirectly depend from Claim 1 and, thus, include all the limitations of Claim 1. Claims 8-12 directly or indirectly depend from Claim 7 and, thus, include all the limitations of Claim 7. Claims 14-18 and 20 directly or indirectly depend from Claim 13 and, thus, include all the limitations of Claim 13. Accordingly, Claims 2-6 and 19 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 1, Claims 8-12 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 7, and Claims 14-18 and 20 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 13.

Accordingly, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of November 24, 2010 be withdrawn, that pending Claims 1-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No. 07-0832.

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